

Application Serial No.09/725,080

**C. REMARKS**

Reconsideration and allowance of the present application are requested in view of the foregoing amendments and the following remarks. Upon entry of this Reply, claims 1, 15, 30, 31, 45, 60, 61, 75, 90, 101, 116, 120, 131 and 136-240 will be pending in the present application with claims 1, 15, 30, 45, 60, 75, 90, 101, 116, and 131 being independent.

**1. Yacoob/Fulcher et al. Rejection**

The Examiner rejected claims 1, 15, 30, 31, 45, 60, 61, 75, 90, 101, 116, 131, 136-146, 148-150, 152-157, 159-169, 171-173, 175-180, 182-192, 194-196, 198-203, 205-212, 214-224, 226-236, 238-240 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,170,742 to Yacoob ("Yacoob") in view of U.S. Patent No. 6,505,774 to Fulcher et al. ("Fulcher").

The Examiner admits that Yacoob fails to teach or suggest "selecting means to select a language from a plurality of choices for use in any printed and displayed text."<sup>1</sup> The Examiner attempts to remedy this admitted deficiency of Yacoob by relying on the teachings of Fulcher. In particular, the Examiner alleges that "Fulcher et al ('774) figure 11 (702) teaches a means for a user to select an alternate language for the convenience of the user and for storage and analysis of customer language preferences"<sup>2</sup> and that "it would have been obvious to one of ordinary skill

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<sup>1</sup> See Office action, at p 3.

<sup>2</sup> *Id.*

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in the art, at the time the invention was made to modify the invention of Yacoob ('742) to include the language selection feature of Fulcher et al ('774) for the benefit of future analysis of language preferences of customers."<sup>3</sup> Applicant traverses this rejection.

The Examiner is reminded that in order to establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.<sup>4</sup> In addition, there must be a reasonable expectation of success.<sup>5</sup> Moreover, the prior art must teach or suggest all of the claim limitations.<sup>6</sup> Such teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure.<sup>7</sup>

Applicant submits that Yacoob and Fulcher cannot be properly combined because the references are in different fields of endeavors and not reasonably pertinent to the particular problem with which each reference was concerned.<sup>8</sup> The Examiner is required to do more than merely point to isolated disclosures of components from the prior art, which are used separately or in other combinations and include no teaching, suggestion, or incentive to make the combination made by the inventor.<sup>9</sup> Applicant submits, therefore, that the outstanding grounds

<sup>3</sup> *Id.*

<sup>4</sup> See MPEP § 2143 citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

<sup>5</sup> *Id.*

<sup>6</sup> *Id.*

<sup>7</sup> *Id.*

<sup>8</sup> See MPEP § 2141.01 citing *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992); *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992); and *Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993).

<sup>9</sup> See *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 934, 15 U.S.P.Q.2d 1321, 1323 (Fed. Cir. 1990).

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of rejections are based on impermissible hindsight reconstruction, using Applicant's claim as a template to reconstruct the claimed invention.<sup>10</sup>

While Applicant disagrees with and traverses the Examiner's grounds rejections, independent claims 1, 15, 30, 45, 60, 75, 90, 101, 116, and 131 have been further amended in order to expedite prosecution. Namely, Applicants have amended the claims to recite "a dealer management system including a customer incentive package linked to a maintenance schedule."

Applicant submits that Yacoob and Fulcher clearly fail to teach or suggest all the elements of independent claims 1, 15, 30, 45, 60, 75, 90, 101, 116, and 131 - in particular, a dealer management system including a customer incentive package linked to a maintenance schedule, as recited. In addition, Applicant submits that Yacoob and Fulcher provide no suggestion or motivation to modify their respective systems to include a dealer management system as recited by independent claims 1, 15, 30, 45, 60, 75, 90, 101, 116, and 131.

In the present Office action, the Examiner attempts to equate the central database of Yacoob with a "dealer management system."<sup>11</sup> In stark contrast to the present invention, however, Yacoob is directed to a computerized "smart card" which has a read/write memory and formatted data storage blocks and which is used to track the life history of an associated machine. Specifically, Yacoob discloses that "[t]he information on the machine 190 is designed

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<sup>10</sup> See In re Fritch, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992).

<sup>11</sup> See Office action at p. 3, for example.

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to be stored on the smart machine card with *possible* backup on either of local or central databases."<sup>12</sup> While Yacoob predominantly teaches storing data on and reading data from the smart card, it describes the incidental function of the central database as follows.

The central 3005 and local 3002 databases are optional and serve backup purposes....The central database is a large database that can store information about a large number of smart machine cards issued by the issuer of the smart machine card, machines that are serviced by the environment, individuals/organizations that are part of the smart machine card machine environment, as well as all information about events, owners and operators of a machine. The purpose of having such a database is primarily for backup but could also be used for accessing useful data to the CPU. The local database 3002 holds a small subset of the central database 3005. Communication between the CPU 3001 and central database 3005 can employ landlinks or wireless links such as through a satellite dish 3006.<sup>13</sup>

Particularly, the CPU 3001 identifies if the machine and the card are members of this smart machine card servicing environment. This is possibly done by accessing the local database and examining the serial number of the machine, the serial number of the card and the password of the machine. The CPU may also access the central database to complete this validation process, in case the smart machine card and/or machine are not listed in local database.<sup>14</sup>

At most, Yacoob discloses a central database that stores smart card data for backup purposes and, in some cases, provides validating data (e.g., the serial number of the machine, the serial number of the card and the password of the machine) to the CPU. Yacoob, however, is devoid of any teaching or suggestion of a dealer management system including a customer

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<sup>12</sup> See Yacoob at col. 6, ll. 32-35 (emphasis added).

<sup>13</sup> See Yacoob at col. 7, ll. 8-10.

<sup>14</sup> *Id.* at col 20, ll. 35-43.

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incentive package linked to a maintenance schedule, as recited by amended claims 1, 15, 30, 45, 60, 75, 90, 101, 116, and 131.

In addition, the portions of Fulcher relied on by the Examiner relate only to a language selection feature and in no way teach or suggest a dealer management system including a customer incentive package linked to a maintenance schedule, as recited.

In view of the above, claims 1, 15, 30, 31, 45, 60, 61, 75, 90, 101, 116, 131, 136-146, 148-150, 152-157, 159-169, 171-173, 175-180, 182-192, 194-196, 198-203, 205-212, 214-224, 226-236, 238-240 clearly recite combinations of features that are neither taught nor suggested by the prior art including Yacoob alone or in combination with Fulcher. Applicant submits that such claims are allowable for at least this reason.

Accordingly, reconsideration and withdrawal of this rejection are requested.

**2. Yacoob/Fulcher/Filepp et al. or Collins-Rector et al. Rejection**

The Examiner rejected claims 120, 147, 151, 158, 170, 174, 181, 193, 197, 204, 213, 225 and 237 as being unpatentable over Yacoob in view of Fulcher and further in view of U.S. Patent No. 5,347,632 to Filepp et al. ("Filepp") or U.S. Patent No. 6,188,398 to Collins-Rector et al. ("Collins-Rector").

The Examiner admits that Yacoob fails to teach or suggest "displaying selecting a language from a plurality of choices for use in any printed and displayed text and displaying pop-up video clips."<sup>15</sup> The Examiner attempts to remedy these admitted deficiencies of Yacoob by

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<sup>15</sup> See Office action, at p 7.

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relying on the teachings of Fulcher and Filepp and/or Collins-Rector. Applicant traverses this rejection.

Applicant submits that Yacoob cannot be combined with Fulcher, Filepp or Collins-Rector. Furthermore, it is clear that, even if combined, such combinations would still fail to teach or suggest all the features of claims 120, 147, 151, 158, 170, 174, 181, 193, 197, 204, 213, 225 and 237.

As set forth above, the teachings of Yacoob and Fulcher fail to teach or suggest "a dealer management system including a customer incentive package linked to a maintenance schedule" and, thus, are insufficient to establish a *prima facie* case of obviousness with respect to the amended independent claims. In addition, the portions of Filepp and Collins-Rector relied on by the Examiner are devoid of any teaching or suggestion of a dealer management system including a customer incentive package linked to a maintenance schedule, as recited by the independent claims.

In view of the above, dependent claims 120, 147, 151, 158, 170, 174, 181, 193, 197, 204, 213, 225 and 237 clearly recite combinations of features that are neither taught nor suggested by the prior art including Yacoob alone or in combination with Fulcher, Filepp and/or Collins-Rector. Applicant submits that such claims are allowable for at least this reason.

Accordingly, reconsideration and withdrawal of this rejection are requested.

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**D. CONCLUSION**

Applicant submits that the present application is in condition for allowance and requests favorable action in the form of a Notice of Allowance. Should the Examiner believe that this application is in condition for disposition other than allowance, the Examiner is invited to contact the undersigned at the telephone number listed below in order to address the Examiner's concerns.

Respectfully submitted,

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